



Paper No. 42

DISCOVISION ASSOCIATES
INTELLECTUAL PROPERTY DEVELOPMENT
2355 MAIN STREET, SUITE 200
IRVINE, CA 92623

In re Application
Application No. 08/485,070
Filed: June 7, 1995
Attorney Docket No. 951028 (US)

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OFFICE OF PETITIONS

ON PETITION

This is a decision on the petition under 37 CFR 1.182, filed May 24, 2001, to withdraw the Terminal Disclaimer filed October 25, 1999, in the above-identified application.

The petition under 37 CFR 1.182 is **dismissed**.

Petitioners request that the Terminal Disclaimer, filed October 25, 1999, in response to the rejection based on obviousness-type double patenting made in the April 7, 1999 Office action be withdrawn. Petitioners assert the aforementioned rejection was improperly instituted. Petitioners have not demonstrated that the circumstances of this application warrant the relief requested.

MPEP 1490 sets forth in pertinent part, "Petitions seeking to reopen the question of the propriety of the double patenting rejection that prompted the filing of the terminal disclaimer have not been favorably considered."

Inspection of the prosecution history of the instant application reveals that the terminal disclaimer was submitted to overcome a rejection for obvious double patenting over the claims of 5,677,899.

It is clear that petitioners are seeking to reopen the question of the propriety of the rejection made in the Office action of April 7, 1999. In essence, petitioner is attempting, by petition, to have the Office determine whether the double patenting rejection was proper.

It is the long-established policy of the Patent and Trademark Office to maintain the line of demarcation between petitionable and appealable subject matter. MPEP 1201. When the question of whether or not a given set of claims in one application or patent is distinct, or lies within the aegis of 35 USC 121, from another set of claims in another application or patent with respect to obviousness double patenting arises, that question relates to the merits of an invention, and the appropriate remedy for resolution of that issue ultimately lies by appeal as provided by statute. See e.g. *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985). As noted by the court in *In re Faust*, 378 F.2d 966, 153 USPQ 813 (CCPA 1967) "the terminal disclaimer eliminates the necessity of considering what are most often exceedingly difficult questions, i.e., whether the subject matter of the appealed claims is obvious in view of the patent claims relied on as the basis for 'double patenting,' thus conserving judicial man hours both here and in the Patent Office." Further, it is well settled that the Commissioner will not, on petition, usurp the functions or impinge upon the jurisdiction of the Board. See *In re Dickerson*, 299 F.2d 954, 958, 133 USPQ 39, 43 (CCPA 1962); *Bayley's Restaurant v. Bailey's of Boston, Inc.*, 170 USPQ 43, 44 (Comm'r Pat. 1971).

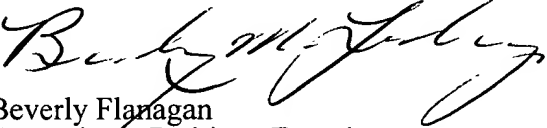
Even assuming, *arguendo*, the relief requested should be considered on petition, petitioners are reminded that, as a general rule, public policy does not favor the restoration to the patentee [applicant] of something that has been freely dedicated to the public, particularly where the public interest is not protected in some manner, e.g., intervening rights in the case of a reissue patent. See Altoona Publix Theatres v. American Tri-Ergon Corp., 294 U.S. 477, 24 USPQ 308 (1935). Petitioners have failed to provide a reasonable, much less any, assurance that the public interest will, or can be, protected if the relief requested in this petition are given favorable consideration. In this regard, an applicant's use, and Office acceptance, of a terminal disclaimer is in the public interest because such encourages the disclosure of additional developments, the earlier filing of patent applications, and the earlier expiration of patents whereby the inventions covered become freely available to the public. See In re Jentoft, 392 F.2d 633, 157 USPQ 363 (CCPA 1968). It is brought to petitioners' attention that the principle against recapturing something that has been intentionally dedicated to the public dates back at least to Leggett v. Avery, 101 U.S. 246 (1879). While petitioners may now consider the previously filed disclaimer to be unnecessary, or unnecessarily limiting, petitioners are, nevertheless, confronted with what has been characterized as "an unhappy circumstance", rather than a circumstance(s) necessitating relief. Jentoft at 639 n. 6, 157 USPQ at 368 n. 6.

Petitioners had the opportunity to challenge the need for a terminal disclaimer, on appeal, but instead freely chose to file a terminal disclaimer to avoid the rejection. Moreover, petitioners have provided no explanation as to why filing of the terminal disclaimer, as opposed to contesting the propriety of the rejection, was caused or contributed to by circumstances beyond petitioners' control. Such does not afford proper legal or public policy grounds for requesting nullification of the terms of free dedication to the public contained in the previously filed terminal disclaimer by way of appeal, much less on petition. Cf. Ex Parte Anthony, 230 USPQ 467 (PBAI 1982) aff'd, No. 84-1357 (Fed. Cir. June 14, 1985).

Petitioner may wish to take note of MPEP 1490 which states in part, "The filing of a continuation application other than a CPA, while abandoning the application in which the terminal disclaimer has been filed, will typically nullify the effect of a terminal disclaimer."

The file is being forwarded to Technology Center 2600 for further processing.

Telephone inquiries should be directed to Petitions Attorney Steven Brantley at (703) 306-5683.



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